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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/036,516 | 01/07/2002 | Shuji Otsuka | 011784 | 5125 |

23850 7590 09/22/2004

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EXAMINER

ZEWDU, MELESS NMN

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

2683

DATE MAILED: 09/22/2004

3

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/036,516

Applicant(s)

OTSUKA ET AL.

Examiner

Meless N Zewdu

Art Unit

2683

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 1/7/02 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

1. This action is the first on the merit of the instant application.
2. Claims 1-33 are pending in this action.

Claim Objections

Claims 1-33 are objected to because of the following informalities: claimed features should be separated by a semi-colon (;) to enhance the claim structure. Claims 1-33 do not provide a separation of features by semi colons and consequently clarity is adversely affected. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 2, 3, 10, 11, 15, 16, 17, 21, 22, 29 and 30 recite the limitation "the user" in the body of these claims. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 15 and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by Jones (US 6,748,318 B1).

As per claim 15: a portable communications device capable of transmitting by radio communication position information representing the position of the device to one or more a plurality of terminal communication units via a position information providing device reads on '318 (see abstract), the portable communication device comprising:

means for preparing a list required for checking whether it is approved to provide the position information for said one or plurality of terminal communications units in response to an information input manipulated by the user reads on '318 (see col. 1, line 52-col. 2, line 8col. 3, lines 20-45).

transmitting means for converting data as to the prepared list to a radio signal and transmitting the radio signal to the position information providing device reads on '318 (see col. 4, lines 7-49).

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As per claim 16: a portable communications device capable of transmitting by radio communication position information representing the position of the device to one or more a plurality of terminal communication units via a position information providing device reads on '318 (see abstract), the portable communication device comprising:

means for receiving position data from a plurality of position reference stations arranged on a satellite and/or the ground reads on '318 (see col. 3, lines 38-44).

position measuring means for measuring the position information based on the position data received reads on '318 (see col. 3, lines 20-38).

transmitting means for converting the measured position information to a radio signal and transmitting the radio signal to the position information providing means reads on '318 (see col. 4, lines 7-49).

control means for discontinuing the information measuring operation of the position measuring means in response to a position measurement discontinuing manipulation by the user reads on '318 (see col. 13, lines 39-60).

Allowable Subject Matter

Claims 1-14 and 17-33 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

The following is a statement of reasons for the indication of allowable subject matter:

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As per claims 1-14 and 17-33: the claims are directed to sending/transmitting location/position information from a portable wireless device to destination terminals via a central controller. The prior art of record does not teach or fairly suggest a portable device that can be manipulated by a user to send/transmit its position information to remote locations/receivers in accordance with a stored list and based on checking as to whether the position information to be sent is approve for the intended users and requested by same, as recited in claims 1-3, 10-11 and 17-22 and 29-30.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Meless N Zewdu whose telephone number is (703) 306-5418. The examiner can normally be reached on 8:30 am to 5:00 pm..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Trost can be reached on (703) 308-5318. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Meless Zewdu

M, Z.

Examiner

16 September 2004.



WILLIAM TROST
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600